

2/20/02

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Paper No. 15  
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Badische Tabakmanufaktur Roth-Händle GmbH

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Serial No. 75/758,023  
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David O'Reilly, Esq. for Badische Tabakmanufaktur Roth-Händle GmbH.

Jan Mooneyham, Trademark Senior Attorney, Law Office 115  
(Tomas Vlcek, Managing Attorney).

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Before Simms, Hairston and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Badische Tabakmanufaktur Roth-Händle GmbH has filed a trademark application to register the mark HOMMAGE 1492 for "tobacco products, namely, cigarette papers, cigarette tubes with and without filters, cigarette filters; smokers' articles, namely, ashtrays not of precious metals, cigarette lighters not of precious metals, pocket machines for rolling and stuffing cigarettes, and matches."<sup>1</sup> The application includes the

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<sup>1</sup> Serial No. 75/758,023, in International Class 34, filed July 22, 1999, based on a German registration under Section 44(e).

Serial No. 75/758,023

statement "the English translation from French of 'hommage' is 'tribute.'"

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for "cigars, little cigars, pipe tobacco, roll your own cigarette tobacco, chewing tobacco and snuff,"<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.



Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that the marks are similar because of the shared number 1492; that 1492 is arbitrary in connection with tobacco products; and that, in applicant's mark, the term HOMMAGE "only reinforces the commercial impression associated with the term '1492'

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<sup>2</sup> Registration No. 1,984,415 issued July 2, 1996, to Consolidated Cigar Corporation, in International Class 34.

by stating what is already implied by the registrant's mark, that the year 1492 is respected as a seminal event in the tobacco industry." With respect to the goods, the Examining Attorney contends that applicant's and registrant's goods are closely related. The Examining Attorney submitted copies of numerous registrations for marks identifying a range of tobacco-related products including both applicant's and registrant's products; and excerpts from Internet web sites offering sales of both tobacco products and applicant's tobacco-related products from a single web site.

Applicant contends that, while both marks include the number "1492," registrant's mark is visually different because the "14" appears above the "92" and the mark includes an oval design and a crown; that 1492 is weak because it has a "fairly well known" relationship to tobacco because it is the year that Columbus brought tobacco back to Europe from the New World; that applicant's mark includes the distinguishing term HOMMAGE; and that the term HOMMAGE in applicant's mark suggests a tribute to the significant year 1492.<sup>3</sup>

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<sup>3</sup> Applicant referred in its brief to two third-party registrations that include "1492" in the marks, but the goods are not revealed and there are no copies of the registrations in the record. This evidence is incomplete, insufficient and untimely; and the Examining Attorney has

Applicant contends that the goods are dissimilar because applicant's goods "are only tobacco related and do not include tobacco of any kind," whereas registrant's goods are tobacco.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in

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objected thereto. We have not considered this evidence. Additionally, applicant submitted copies of excerpts from two publications purported to support the significance of 1492 to the tobacco industry. However, these excerpts are in the German language, with no English translation. Thus, this evidence has not been considered. Applicant has not submitted any evidence establishing the significance of 1492 in relation to tobacco products or the relevant consuming public's awareness of the same.

Serial No. 75/758,023

their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Thus, if both words and a design comprise the mark, then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by them to request the goods and/or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553,

Serial No. 75/758,023

1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also: *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Registrant's mark consists of the number "1492," with the number "14" appearing directly above the number "92," both numbers are centered within the circle, and the crown design is smaller than the other features and appears at the very top of the mark above the circle. Regardless of whether the numbers appear horizontally, as in applicant's mark, or vertically, as in registrant's mark, it is likely that the number will be pronounced as "1492." Because the number is centered and larger than the other elements of registrant's mark, "1492" is likely to be perceived as the dominant portion of registrant's mark, and it is likely to be the term used to ask for registrant's goods.

With regard to applicant's mark, HOMMAGE 1492 is likely to be perceived as a unitary term. There is insufficient evidence to indicate that either "HOMMAGE" or "1492" is likely to be perceived as dominant. There is no evidence in this record that "1492" is other than an arbitrary term in relation to tobacco-related products. Because the French work "hommage" is merely

Serial No. 75/758,023

one letter different from the English word of the same meaning, "homage," the connotation of applicant's mark is likely to be perceived as "paying homage to 1492." While the two marks are clearly different, applicant's mark incorporates the arbitrary and dominant portion of registrant's mark, "1492." Applicant's mark, if used in connection with related products, is sufficiently similar in commercial impression to registrant's mark that it is likely to be perceived as a variation of registrant's mark identifying, perhaps, a different product within the same line of products.

Turning to consider the goods or services involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be

identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Applicant's identified products are essentially goods used to roll tobacco into cigarettes and to smoke cigarettes. Registrant's identified products are tobacco in several forms. Applicant admits that its products are tobacco-related and that registrant's products are tobacco products. It is clear from the evidence submitted by the Examining Attorney that the consuming public is accustomed to seeing both types of products identified by a single mark. Thus, we conclude that applicant's and registrant's goods are closely related.

Therefore, we conclude that in view of the similarity in the commercial impressions of applicant's

Serial No. 75/758,023

mark, HOMMAGE 1492, and registrant's mark, a design mark prominently featuring the number "1492," their contemporaneous use on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Finally, it is well established that one who adopts a mark similar to the mark of another for the same or related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

*Decision:* The refusal under Section 2(d) of the Act is affirmed.